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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,576	08/30/2001	Sergio Stiberman	41693.010100	2548
4219	7590	05/16/2006	EXAMINER	
MALLOY & MALLOY 2800 S.W. THIRD AVENUE HISTORIC CORAL WAY MIAMI, FL 33129			AIRAPETIAN, MILA	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/943,576	STIBERMAN, SERGIO	
	Examiner	Art Unit	
	Mila Airapetian	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/02/2006 has been entered.

Response to Amendment

Applicant's amendment received on 05/02/2006 is acknowledged and entered. The applicant added claim 18. Currently, claims 1-18 are pending for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph (US 2005/0165661) in view of Ginter et al. (US 6,185,683).

Claim 1. Joseph teaches a system for facilitating transfer or vehicle leases comprising:

means for receiving used leased vehicle and existing lease agreement information submitted electronically by or on behalf of said current lessee and storing said information in a searchable database (claim 30, page 8; [0042], [0043], [0046]);

means for providing said used leased vehicle and existing lease agreement information electronically to prospective new lessees in response to electronic queries to said searchable database submitted by or on behalf of said prospective new lessees [0030];

means for said prospective new lessees to receive vehicle selection information submitted electronically by or on behalf of said current lessees ([0010], [0049]);

means for notifying electronically said current lessees whose used leased vehicles are selected by prospective new lessees of said selection so that the parties can negotiate and complete a leased vehicle transfer transaction [0043];

means for receiving and processing insurance application information submitted electronically by or on behalf of said current lessees or prospective new lessees with respect to vehicles selected by said prospective new lessees for insurance covering the current lessee's liability under the existing lease agreement for said vehicle in the event of lease default by the prospective new lessee after transfer of said vehicle and assignment of said lease agreement to said new lessee [0045];

means for submitting said insurance application information to one or more insurers for application processing and approval [0045], [0050]; and

means for arranging for vehicle and lease transfer and insurance document delivery, payment [0044], [0050]. Furthermore, finalizing the lease/transaction and delivering product to the customer indicates delivering all required by the lease/transaction documents, including insurance documents.

However Joseph does not teach means for arranging a vehicle delivery.

Ginter teaches a system for item delivery and execution wherein the car is delivered to the buyers (col. 51, lines 33-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joseph to include means for arranging a vehicle delivery, as disclosed in Ginter, because it would advantageously allow the customer to receive the purchased vehicle at a convenient time and location, thereby increasing customer service.

Claim 2. Joseph teaches said system wherein said means for receiving used vehicle and existing lease agreement information comprises a series of customized leased vehicle data entry screens made accessible to current lessees via a global computer network, whereby current lessees can create customized listings for their vehicles [0042].

Claim 3. Joseph teaches said system wherein said means for notifying electronically current lessees whose used vehicles are selected by prospective current lessees of said selection further comprises messaging means current lessees and

prospective new lessees to negotiate and complete a leased vehicle transfer transaction [0033], [0041].

Claim 4. Joseph teaches said system wherein said messaging means comprises Internet e-mail communications protocols [0002].

Claim 6. Joseph teaches said system further comprising means for prospective new lessees to submit their vehicle preferences for matching with leased vehicle data stored in said system's searchable database [0007], [0030].

Claim 7. Joseph teaches said system further comprising means for prospective new lessees to submit their lease term preferences for matching with leased term data stored in said system's searchable database [0030].

Claim 8. Joseph teaches said system further comprising means for notifying prospective new lessees of leased vehicle data stored on said system's searchable database that matches said prospective new lessee's leased preferences [0007], [0041].

Claim 9. Joseph teaches said system further comprising means for notifying prospective new lessees of leased term data stored on said system's searchable database that matches said prospective new lessee's lease term preferences [0007], [0041].

Claim 10. Joseph teaches said system further comprising means for receiving lease assumption application information submitted electronically by or on behalf of prospective new lessees with respect to vehicles selected by said prospective new lessees for transfer of said leased vehicle [0031].

Claim 11. Joseph teaches said system further comprising means for arranging for lease assumption document and delivery [0032].

Claim 16. Joseph teaches said system further comprising means for receiving and processing prospective new lessee credit verification information [0032].

Claim 17 is rejected on the same rationale as set forth above in Claim 1.

Claim 18. Joseph teaches a method for facilitating transfer or vehicle leases comprising:

storing used leased vehicle and existing lease agreement information submitted electronically by or on behalf of the current lessee and storing the information in a searchable database (claim 30, page 8; [0042], [0043];

accessing the used leased vehicle and existing lease agreement information electronically in response to electronic queries to the searchable database submitted by or on behalf of the prospective new lessees [0010];

receiving vehicle selection information submitted electronically by or on behalf of current lessee (claim 30, page 8; [0042], [0043]);

notifying the prospective new lessees of leased vehicle data stored on the searchable database that matches the prospective new lessees' leased preferences stored in a with list [0007], [0010];

notifying the prospective new lessees of leased term data stored on said searchable database that matches the prospective new lessees' leased term preferences stored in the with list [0043]; and

arranging for vehicle and lease transfer and payment [0044], [0050].

Furthermore, finalizing the lease/transaction and delivering product to the customer indicates delivering all required by the lease/transaction documents.

However, Joseph does not teach arranging for physical delivery of the used leased vehicle.

Ginter teaches a system for item delivery and execution wherein the car is delivered to the buyers (col. 51, lines 33-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Joseph to include means for arranging a vehicle delivery, as disclosed in Ginter, because it would advantageously allow the customer to receive the purchased vehicle at a convenient time and location, thereby increasing customer service.

Claim 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Joseph and Ginter teachings, as applied to claim 1, in view of Murphy et al. US 2002/0052778 (hereinafter referred to as "Murphy").

Claim 12. The combination of Joseph and Ginter teaches all the limitations of claim 12 except that said system further comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees.

Murphy teaches a system for providing incentives to purchasers wherein said system further comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees [0141].

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph and Ginter to include that said system comprising means for leased new vehicle dealers to submit vehicle and lease information electronically that is not accessible by other current lessees, as disclosed in Murphy, in order to allow for interactive incentives within a dealership to force a consumer to work with a certain dealership [0032].

Claim 13. The combination of Joseph and Ginter teaches said system further comprising means for current lessees to initiate communications with prospective new lessees that have accessed current lessee's vehicle and lease information stored on said system's searchable database prior to notification of vehicle selection by a prospective new lessee [0033].

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of Pecone (US 5513329).

Claim 14. The combination of Joseph and Ginter teaches all the limitations of claim 14 except that said system further comprising means for prospective new lessees to purchase vehicle feature upgrades.

Pecone teaches a computer system to be upgraded at any time during the manufacture or in the field wherein the consumer need to purchase only the minimum

computer system needed and, when ready for more features, purchase additional features (col. 2, lines 53-63).

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph and Ginter to include that said system further comprising means for prospective new lessees to purchase vehicle feature upgrades, as disclosed in Pecone, because it would allow a customer to have a feature upgrades at a later date (col. 3, lines 15-19).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joseph in view of DeWolf (US 2002/0032626).

Claim 15. The combination of Joseph and Ginter teaches all the limitations of claim 15 except that said system further comprising means for prospective new lessees to purchase leased vehicle warranties/maintenance plans.

DeWolf teaches global asset information registry wherein various organizations such as manufacture, a dealer, an owner, a buyer, an insurance company, etc. may write data to and read data from the master record, including information about the vehicle, e.g. warranties [0102].

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph and Ginter to include that said system further comprising means for prospective new lessees to purchase leased vehicle warranties/maintenance plans, as disclosed in DeWolf, because warranties ensure

customers that they will receive a repair or replacement of the broken parts of the vehicle.

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over Joseph in view of official notice.

Claim 5. The combination of Joseph and Ginter does not explicitly teach that said messaging means comprises instant peer-to-peer communications protocols.

However, examiner takes official notice of the concept and benefit of the notoriously well-known practice of peer-to-peer communication at the time of the applicant's invention. For example, using walkie-talkies is peer-to-peer. An important goal in peer-to-peer networks is that all clients provide resources, including storage space, and computing power. The distributed nature of peer-to-peer networks also increases robustness in case of failures by replicating data over multiple peers.

In view of the official notice, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Joseph to include the feature that said messaging means comprises instant peer-to-peer communications protocols because in peer-to-peer networks clients directly communicate with another, as opposed to each client referring to a common server so peers can always find the data without relying on a centralized server.

Response to Arguments

In response to Applicant's argument that Joseph provisional application 60/180,264 does not support the cited paragraphs of the Joseph patent application

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11/089,610, it is noted that Joseph provisional application does, in fact, support those features. Specifically, paragraph [0042] in Joseph patent application is supported by page 2, lines 9-19 in provisional application; [0010] is supported by page 2, lines 20-23, page 4, lines 9-11; [0047] and [0050] are supported by page 6, lines 29-30.

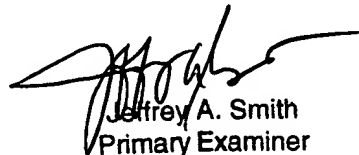
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA



Jeffrey A. Smith
Primary Examiner